

Patent /Atty. Docket No. 34321.3
Customer No. 000027683

III. REMARKS

A. Status of the Application

Claims 33, 42, 45-47, 50-52 and 69-71 are pending. Claims 1-32, 34-41, 43-44, 48-49 and 53-68 have been cancelled. Claim 33 has been amended. It is respectfully submitted that claim 33, as amended, is supported by the specification as filed and is in condition for allowance.

B. Declaration of Wayne J. Falcon

Submitted herewith is the Declaration of the applicant, Wayne J. Falcon. The Falcon Declaration refers to several magazine articles which substantiate the patentability of the claimed subject matter. Specifically, the magazine articles demonstrate that the claimed lure has unexpectedly improved performance that is attributable to the location of the weight on the hook shank and the shape of the weight in terms of being tapered at both ends and in terms of being disposed concentrically about the hook shank.

C. Rejection Under 35 U.S.C. §103(a)

Claims 33, 34, 36, 42, 43, 45-48, 50-52 and 69-71 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,691,449 to Hoben ("Hoben"), in view of U.S. Patent No. 2,185,666 to Hill ("Hill") and further in view of U.S. Patent No. 5,335,443 to Grigsby ("Grigsby") and U.S. Patent No. 6,519,895 to Bennett ("Bennett"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

According to MPEP § 2142, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations.

Applying the criteria set forth in MPEP § 2142, Applicant submits that none of Hoben, Hill, Grigsby or Bennett teach, motivate or suggest all of the limitations of independent claim 33 or the claims dependent thereon, namely, claims 42, 45-47, 50-52 and 69-71.

Regarding the third criteria of a *prima facie* case of obviousness, none of Hoben, Hill, Grigsby or Bennett disclose or suggest a lure that includes a hook at least partially embedded in said

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ture body and a weight that is concentrically disposed about the shank of the hook in the particular location claimed, in which the weight has a middle portion, a first end and a second end wherein the weight symmetrically tapers from the middle portion to the first and second ends thereof, respectively. Accordingly, none of Hoben, Hill, Grigsby or Bennett disclose or suggest all of the limitations of claim 33.

In addition, there is no suggestion or motivation to modify any of Hoben, Hill, Grigsby or Bennett to include all of the limitations of claim 33 as noted above. Without a suggestion or motivation to so modify Hoben, Hill, Grigsby or Bennett, there could be no reasonable expectation of success.

Accordingly, Applicant submits that a prima facie case of obviousness over Hoben, Hill, Grigsby or Bennett has not been made with respect to claim 33 because none of the three criteria of the prima facie case has been satisfied. Applicant further submits that the prima facie case also fails with respect to claims 42, 45-47, 50-52 and 69-71, each of which depends directly or indirectly from claim 33 for at least the same reasons as apply to claim 33.

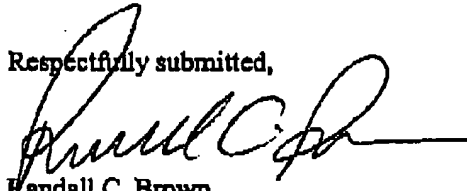
In view of the foregoing, Applicant requests that the rejection of claims 33, 34, 36, 42, 43, 45-48, 50-52 and 69-71 under 35 U.S.C. § 103(a) over Hoben in view of Hill in view of Grigsby and Bennett be withdrawn.

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D. Conclusion

Claims 33, 42, 45-47, 50-52 and 69-71 are now pending in the present application. In view of the foregoing amendments and remarks, allowance of all pending claims is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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